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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,195	06/03/2002	Risto Makipaa	01-1727	8320
20306 7590 04/03/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER LOFTUS, ANN E	
			ART UNIT 3694	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			04/03/2007	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/980,195	<b>Applicant(s)</b> MAKIPAA, RISTO	
	<b>Examiner</b> Ann Loftus	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/3/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/30/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

**-DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities:

- On page 1, lines 17 and 19, the word packets is used where packages is probably intended. Software packets are structures of bits passed over a network. The examples given are software packages.
- On page 2, lines 31-34, the claim numbers refer to cancelled claims.
- On page 8, line 32, "SPL" is either unexplained or intended to be "SLP."
- On page 9, lines 11 and 19 refer to non-existing figures.

Appropriate correction is required.

The abstract of the disclosure is objected to because it exceeds the maximum length of 150 words. Correction is required. See MPEP § 608.01(b).

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 11/30/2001 is being considered by the examiner.

***Claim Objections***

3. Claims 28, 44, 49, and 53 are objected to because of the following informalities:

In claim 28, line 7, the word "the" in front of parameters suggests reference to previously defined parameters. Deleting the word "the" would clarify the claim. Also the phrase "according to the parameters given by the client and said service attributes" could be interpreted to modify either the selection or the billing.

In claims 44 and 53, the following language is suggested in order to improve word order and avoid the suggestion of missing antecedents: "Wherein the server uses the billing services for client billing transactions, and the server receives advertising messages with address data and service attributes of the billing services".

Claim 49 has similar problems, where the word "the" suggests an antecedent that is not found. Deleting the word "the" from the beginning of line 4 and changing line 5 to start "advertising message to a service provider's server..." improves clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32-34 and 36-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32, 33, 34, 36, 37, 39, 41, 42, 44, 46, 47, 48, 49, 50, 51, and 53 have the issues stated below. Claims 38, 40, 43, 45, 52 and 54 are rejected as depending on rejected claims.

In claims 32 and 46, reference is made to a transaction "controlled" by the billing server. It is unclear how this may apply. The amounts of the transaction are set at this point. The timing of the exchange of web pages and data rests largely with the user. Would that mean that since the billing server does not control timing or amounts, it is not in control, and such an embodiment be outside the limitations of the claim? The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claims 33 and 47, reference is made to functioning as a party in a procedure. The extent of involvement necessary is unclear. For example, would supplying a logo be functioning as a party in the procedure? The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claim 34 and 48, the phrase "and/or" is unclear as to whether both clauses are required, or one is sufficient. Also the phrase "configures with... on the basis of" is awkward. Common usage is to configure a device to handle a protocol using data. The construction "is configured to handle ... using" would be clearer. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claims 36 and 41, it appears as though the client has made payments and then gets billed for them. Is it obligations that are collected and billed? Or perhaps the word "it" refers to the billing server and not the client? Are the client's payments made by the client or on the client's behalf? Further, the word "suitable" is subjective and could vary from person to person. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claims 37 and 42, it seems as though the phrase "client's service payments" is in fact referring to an obligation and not to money paid. This is contrary to the ordinary use of the term payment and leads to confusion. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claim 39, line 7, "said service parameters" lacks antecedent basis. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claim 44, line 6, "the advertised billing servers" and "the parameters" lack antecedent basis. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claims 49 and 53, the term "corresponds to the requirements" does not indicate whether the requirements must be met or not. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claim 50, the term "places the actual order" is misleading because in common usage, that would include billing arrangements, rather than follow it. Perhaps the phrase "requests the procured service" would fit. As is, the metes and bounds of the claim are not clear, and therefore the claim is rejected.

In claim 51, "electronic page" has no antecedent basis. The metes and bounds of the claim are not clear, and therefore the claim is rejected.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3694

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 28-36, 39-41, and 44- 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5978840 issued Nov. 2, 1999, hereafter referred to as Nguyen, and further in view of the Service Location Protocol (SLP). The Service Location Protocol is documented by a Request for Comments dated June 1997, put out by the Network Working Group of the Internet Engineering Task Force (IETF), <http://www.ietf.org/rfc/rfc2165.txt?number=2165> as well as mentioned in the disclosure. Nguyen and SLP are both directed toward providing software services. Nguyen does not specifically address how its services are located; SLP solves the problem of manually locating suitable services by establishing directories of services. It would have been obvious to modify Nguyen to function automatically with the service finding features of SLP in order to reap the benefit of skipping finding services manually.

As to claims 28 and 44, Nguyen teaches offering billing services for the client to select (Fig. 32) and the service provider's server initiating the billing transaction with the billing server (Figs 28 and 35). Nguyen also teaches protocol substitution (col 2 near line 57 and col 3 near line 33 and col 12 line 3). Nguyen does not teach address data and service attributes of services transmitted in an advertising message over a data transfer network to the service provider's server. SLP teaches address data and service attributes of services transmitted in an advertising message over a data transfer network to the service provider's server (section 14), and selection of a service (abstract). It would have been obvious to a person of ordinary skill in the art at the time

of the invention to combine them because it would stand to reason that means to find services on small networks could be adapted for larger networks and complex services.

Claim 39 recites limitations already rejected under claim 28 with the additional concept of a directory server to transmit address data and service attributes. The analysis for its rejection is as above, with the addition of: SLP teaches a directory server to transmit address data and service attributes in section 15. This is a part of the service finding features of SLP, and motivation to modify Nguyen would be as above.

As to claims 29 and 45, SLP teaches an advertising message in response to a request in section 3, the Protocol Overview. This is a part of the service finding features of SLP, and motivation to modify Nguyen would be as above.

As to claim 30, SLP teaches a service request sent in response to parameters from the client in section 5.1. This is a part of the service finding features of SLP, and motivation to modify Nguyen would be as above.

As to claim 31, in col 13, in lines 30-34, Nguyen teaches a digital payment and billing protocol supported by the billing server to conduct a transaction.

As to claims 32 and 46, Nguyen teaches a handshake before the transaction by referring to initial server contact by that name in col 14 near line 9.

As to claims 33 and 47, Official Notice is taken that the application software loaded on a server is normally limited to what is functionally necessary. Billing software would normally be limited to that necessary to perform the billing function, according the server's role. If the service provider's server's role in billing were to track and select a suitable billing server, handshake with it, and function as a party in a payment or billing



procedure supported by the billing server, then it would have been obvious to a person of ordinary skill in the art at the time of the invention to limit that server's software to the software necessary for the role.

As to claims 34 and 48, Nguyen col 3, lines 35-65 describe how fourteen hundred different payment-related applications are supported by one company. Nguyen does not teach distributing configuration settings with the service advertising message. Official Notice is taken that a billing or payment protocol would routinely require some settings or configuration. Since data can be passed from the billing server to the service provider's server in the attributes describing the service, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use that data to pass configuration settings for the service provider's server.

As to claims 35 and 40, Nguyen teaches the billing server verifying the client and making the payment in col 76 line 45.

As to claims 36 and 41, Official Notice is taken that the bank behind a credit card often aggregates payments made to different service providers on the client's behalf and bills the client for them in a combined invoice at suitable intervals. It would have been obvious to a person of ordinary skill in the art at the time of the invention that a billing server (payment gateway) such as Nguyen could operate in such a fashion.

8. Claims 37, 38, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen, and further in view of the Service Location Protocol (SLP) and further in view of Christy Hudgins' Nov 15, 1999 article from Network Computing.

The article is titled "International E-Commerce—Get the lowdown on the toughest obstacles to going global, from calculating shipping, taxes and other charges, to showing prices in local currencies."

As to claims 37 and 42, on page 3 near the top, Hudgins teaches two online billing services wherein the client's service payments are billed in a service invoice of a telecommunications operator with which the client has a service agreement.

As to claims 38 and 43, Official Notice is taken that businesses often use identifiers for their clients such as network address (for online businesses), or by data from a service agreement such as last name and phone number. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use such data as the client's identifier in order to have a unique way to differentiate customers.

9. Claims 49-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over e-BX from IBM and further in view of the Service Location Protocol (SLP). E-BX is documented in an article by Lesley Moore titled "Malaysia's e-BX Pushes Internet Billing Concept" from Newsbytes on 26 Nov 1999.

As to claims 49, 52 and 53, Moore teaches a method where

- an electronic invoice form which corresponds to the requirements of a billing service is generated;
- the form is sent to a client device in response to a purchase transaction initiated by the client;
- the client adds his billing data to the invoice form;

- the invoice form is then transferred to the billing server;
- and the billing server sends an acknowledgement of the payment to the client and the service provider's server.

Moore does not teach address data and service attributes of services transmitted in an advertising message. SLP teaches address data and service attributes of services transmitted in an advertising message over a data transfer network to the service provider's server (section 14). It would have been obvious to a person of ordinary skill in the art at the time of the invention that the SLP could have been used in conjunction with an online billing service because SLP was a known solution to the problem of dynamically updating services on a network.

As to claim 50, Official Notice is taken that it is old and well-known to send a special link to a client in order to allow access to a restricted service. A code can be embedded in the link that will be received by the server and can be tested to determine whether access will be granted. This approach is particularly useful because the client does not have to remember and re-enter the code. It would have been obvious to a person of ordinary skill in the art at the time of the invention to send the client a page with a link that allowed access to the purchased service.

As to claim 51, Official Notice is taken that HTML and WAP standards use forms with fields as common ways to move information around a network such as the Internet. It would have been obvious to a person of ordinary skill in the art to implement an electronic page or form using World Wide Web pages or Wireless Application Protocol.

As to claim 54, Official Notice is taken that it is old and well-known for a service provider to provide a purchased service after receiving payment information.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US Patent No. 6304857, Heindel et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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ELLA COLBERT  
PRIMARY EXAMINER